

REMARKS

Claim 1 is amended, no claims are canceled, and no claims are added; as a result, claims 1-14 are now pending in this application.

§103 Rejection of the Claims

Claims 1-5, 8, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hershey (U.S. Pat. No. 5,867,963) in view of Leung (U.S. Pat. No. 6,308,469). Applicant respectfully traverses the rejection of claims 1-5, 8, and 10.

The Office Action must provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action, in an attempt to meet this requirement on page 3 states, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide at least two planks in an inclined branch in order to enable the structure to withstand the design forces." Applicant disagrees. Leung at column 1, lines 10-12 states, "Shear walls or shear wall panels are used to resist lateral forces in a structure created, for example, by wind loads applied to the side of a structure or earthquakes." (emphasis added) In contrast, Hershey at column 7, line 61 through column 8 line 2 recites,

There is seen in FIG. 7 a force-loading diagram of the improved trimmable truss 20. As seen, the upwardly directed force (arrow A in FIG. 7) places the trimmable end 34A in compression when downwardly directed forces (per arrow B in FIG. 7) are applied to the truss 20 along the upper chord 22. Such centrally-located downwardly-directed loading forces are normally applied, such as by roofing components, air handling equipment (neither shown) or otherwise. (emphasis added)

Hence, Leung is concerned with lateral forces in a shear wall caused by wind and earthquakes, while Hershey is concerned with upward and downward forces in a truss caused by roofing components and air handling equipment. Since the cited documents are concerned with different forces in different type structures caused by different means, the statements in the Office Action are not supported by the disclosures in Leung and Hershey. Thus, the Office Action fails to provide specific, objective evidence of record for a finding of a teaching, suggestion, or

motivation to combine Leung and Hershey as required by *In re Sang Su Lee*. Therefore, the Office Action fails to state a *prima facie* case of obviousness with respect to claims 1-5, 8, and 10.

Even assuming *arguendo* that Hershey and Leung are not improperly combined, the Office Action still fails to state a *prima facie* case of obviousness with respect to claims 1-5, 8, and 10 because the cited documents, alone or in combination, fail to teach or suggest each of the elements in the claims.

For example, claim 1 as amended recites, "wherein each plank of a V-shaped structural element is joined at said lower chord to form a single connection therewith and two connections to said upper chord." (emphasis added) The Office Action states on page 3 that Hershey discloses these elements, referring to attached figure 1. Applicant respectfully notes that the attached figure 1 is Figure 5 from the Leung patent, and therefore can not be used to indicate any disclosure attributed to Hershey. Further, Hershey at column 3, lines 8-13 discloses web members 28 "each of which are connected at their respective ends to the respective upper and lower chords 22, 24." Since each web member of Hershey is connected to both the lower and upper cords, the V-shaped structural elements of Hershey consist of two connections to the lower cord and two connections to the upper cord, that is four connections, as opposed to the "single connection therewith and two connections" recited in claim 1. Therefore, Hershey fails to teach or suggest these elements of claim 1. Leung discloses at column 3, lines 31-36, vertices at the upper horizontal member, and the vertical member. Therefore, Leung also fails to teach or suggest "wherein each plank of a V-shaped structural element is joined at said lower chord to form a single connection therewith and two connections to said upper chord" as recited in claim 1.

In a further example, claim 1 as amended recites, "each said inclined branch of said connector members being formed of at least two planks each having a rectangular cross-section consisting of opposite side faces and opposite side edges and having adjacent side edges adhesively joined to one another." (emphasis added) The Office Action on page 3 admits that Hershey does not disclose these elements, but relies on Leung. However, claim 1 requires that the at least two planks be "adhesively joined to one another." The Office Action has pointed to

no portion of Leung teaching or suggesting that the planks of the inclined branch be adhesively joined.

For at least the reasons stated above, Applicant submits that neither Hershey nor Leung, either alone or in combination, teach or suggest each of the elements of claim 1. Claims 2-5, 8, and 10 depend from claim 1, and so include all the elements of claim 1. Thus, the Office Action fails to state a *prima facie* case of obviousness with regards to claims 1-5, 8, and 10. Therefore, Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claims 1-5, 8, and 10.

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hershey (U.S. Pat. No. 5,867,963) in view of Leung (U.S. Pat. No. 6,308,469) and further in view of Koo (U.S. Pat. No. 5,592,880). Claims 9 and 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hershey (U.S. Pat. No. 5,867,963). Applicant respectfully traverses. These claims depend at least in part on claim 1. Applicant can not find where these additional documents teach the features recited in the claims that are not found in the principal applied document, Hershey. Accordingly, these dependent claims are believed to be allowable with claim 1. Withdrawal of the rejection of claims 6-7, 9, and 11-13 is respectfully requested.

With regard to claims 9 and 11-13, the Office Action makes numerous assertions as to what would be obvious to one of skill in the art. Applicant traverse. Applicant respectfully submits that the numerous assertions of what would be "obvious to one of ordinary skill in the art at the time the invention was made" failed to provide the recited subject matter of the rejected claims. Traversal and, references or an affidavit from the Examiner pursuant to MPEP 2144.03 are respectfully requested.

Claims 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Leung (U.S. Pat. No. 6,308,469) in view of Hershey (U.S. Pat. No. 5,867,963). Applicant respectfully traverses the rejection of claim 14.

Claim 14 recites, "the first side being adhesively secured to the second side, the first and third ends being adhesively secured to the first chord, and the second and fourth ends being adhesively secured to second chord." The Office Action on page 5 admits that Leung does not

disclose these elements, but relies on column 4, lines 38-44 of Hershey which states, "Alternatively, the web 50 could be formed of a suitable glued wooden flakeboard panel, also known as OSB board." A disclosure of glued wooden flakeboard is not a teaching or suggestion of "the first side being adhesively secured to the second side, the first and third ends being adhesively secured to the first chord, and the second and fourth ends being adhesively secured to second chord" as recited in claim 14. Therefore, neither Leung nor Hershey, either alone or in combination, teach or suggest each of the elements of claim 14.

Further, since neither Leung nor Hershey teach or suggest adhesively securing the structural elements, the statement on pages 5-6 of the Office Action -- "It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the adhesive as taught by Hershey with the planks of Leung" -- is not supported by the record. The Office Action thus fails to provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine Leung and Hershey as required by *In re Sang Su Lee*.

For at least the reasons stated above, the Office Action fails to state a *prima facie* case of obviousness with respect to claim 14, so the Applicant respectfully requests withdrawal of the rejection and reconsideration and allowance of claim 14.

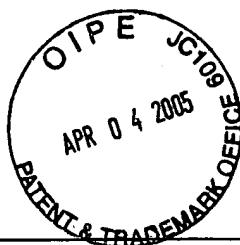
In addition, the Office Action on page 6 states, "it would have been obvious to one having ordinary skill in the art at the time of the invention was made to provide the second and forth ends to be secured to the second chord, since it has been held that rearranging parts of an invention involves only routine skill in the art." Applicant respectfully disagrees and traverses the statement, and pursuant to MPEP 2144.03 requests that the Examiner provide one or more references or an affidavit that describes how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of claim 14.

Reservation of Rights

Applicant does not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

Supplemental Information Disclosure Statement

Applicant respectfully requests that a copy of Form 1449, listing all references that were submitted with the Supplemental Information Disclosure Statement filed on January 8, 2003, marked as being considered and initialed by the Examiner, be returned with the next official communication.



CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

31 March '05

By Timothy B. Chase
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 31st day of March, 2005.

Name

Domenic De Luca Signature